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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,030	11/04/2003	Thomas L. Kelly	KES-0004	6735
23413	7590	12/13/2007		
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			EXAMINER DREIDAME, HUNTER M	
			ART UNIT 3633	PAPER NUMBER
			MAIL DATE 12/13/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/702,030

**Applicant(s)**

KELLY, THOMAS L.

**Examiner**

Hunter M. Dreidame

**Art Unit**

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 16 October 2007 has been entered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,204,148 to Alexander, et al.**

**As to claim 1**, Alexander et al. disclose the steps of locating fasteners (20, Fig. 4) in a roof construction (Fig. 4); positioning an individual piece of energy absorbing material (3, Fig. 3) to discretely cover each individual fastener of said fasteners whereby said fastener is completely covered by said material; and affixing said material to said fastener (Fig. 5). Although Alexander et al. don't explicitly disclose a method for reducing roof membrane damage from hail/fastener contact, it is inherent through the steps provided and the physical properties of the invention disclosed by Alexander et al.

that the method as shown is capable of reducing roof membrane damage from hail/fastener contact.

**As to claim 2**, Alexander et al. disclose a method for reducing roof membrane damage from hail/fastener contact as claimed in Claim 1 wherein said affixing is by adhering (line 11, col. 5).

**As to claim 3**, Alexander et al. disclose a method for reducing roof membrane damage from hail/fastener contact as claimed in Claim 2 wherein said adhering is by a self stick adhesive applied to said energy absorbing material (line 11, col. 5).

**As to claim 4**, Alexander et al. disclose a roof system (Fig. 4) with reduced hail/fastener impact damage characteristics comprising a roof substrate (18, 19, Fig. 4) having one or more layers of material; at least one fastener exposed at a top surface of said substrate; an individual piece of dedicated energy absorbing material (3, Fig. 3) positioned to discretely cover each individual fastener of said at least one fasteners; and a roof waterproofing membrane (2, Fig. 3) positioned atop all foregoing elements.

**As to claim 5**, Alexander et al. disclose a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 4 wherein said one or more layers of material includes insulation (19, Fig. 4).

**As to claim 6**, Alexander et al. disclose a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 4 wherein said energy absorbing material is cover tape (lines 12-2, col. 5).

**As to claim 7**, Alexander et al. disclose a roof system with reduced hail/fastener impact damage

characteristics as claimed in claim 4 wherein said energy absorbing material is a self-sticking cover tape composed of cured ethylene propylene diene monomer (EPDM) membrane (lines 12-26, col. 5) with a butyl gum rubber bottom (lines 12-26, col. 5).

**As to claim 8**, Alexander et al. disclose a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 6 wherein said cover tape is ethylene propylene diene monomer (lines 12-26, col. 5).

**As to claim 9**, Alexander et al. disclose a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 6 wherein said cover tape is self-adhesive tape (line 59, col. 1).

**As to claim 10**, Alexander et al. disclose a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 4 wherein said energy absorbing material is two layers (27, 3, Fig. 4).

**As to claim 11**, Alexander et al. disclose a roof system with reduced hail/fastener impact damage characteristics as claimed in Claim 10 wherein said two layers comprise a first layer (27, Fig. 4) covering a fastener (20, Fig. 4) and a second layer (3, Fig. 4) covering the first layer and a washer (23, Fig. 4) of the fastener.

**As to claim 12**, Alexander et al. disclose a method for reducing roof membrane damage from hail/fastener contact as claimed in Claim 1 wherein said energy absorbing material is installed on top of the roof membrane in an area directly over an underlying fastener (shown in Fig. 3).

**As to claim 13**, Alexander et al. disclose a roof system (Fig. 4) with reduced hail/fastener impact damage characteristics comprising a roof substrate (18, 19, Fig. 4)

having one or more layers of material; at least one fastener (20, Fig. 4) exposed at a top surface of said substrate; a roof waterproofing membrane (2, Fig. 4) positioned over said at least one fastener; and an individual piece of dedicated energy absorbing material (3, Fig. 4) positioned to discretely cover each individual fastener of said at least one fastener (shown in Fig. 3).

**As to claim 14**, Alexander et al. disclose a roof system with reduced ail/fastener impact damage characteristics as claimed in Claim 4 wherein at least one layer of said energy absorbing material is dimensioned to only cover a fastener head of said at least one fastener (shown in Fig. 3).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hunter M. Dreidame whose telephone number is (571)272-5177. The examiner can normally be reached on Monday - Friday 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Canfield can be reached on (571)272-6840. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Hunter Dreidame, Patent Examiner  
December 9, 2007

Robert Canfield  
Patent Examiner

